

9/28/01

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Paper No. 12
RLS/kes

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BP Amoco p.l.c.

Serial No. 75/672,371

Robert E. Blankenbaker for BP Amoco p.l.c.

William J. Sauers, Trademark Examining Attorney, Law Office
114 (K. Margaret Le, Managing Attorney).

Before Simms, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

BP Amoco p.l.c. (applicant), a United Kingdom
corporation, has appealed from the final refusal of the
Trademark Examining Attorney to register the mark VISCO for
lubricants for automobiles.¹

The Examining Attorney has refused registration under
Section 2(d) of the Act, 15 USC §1052(d), on the basis of
Registration No. 32,900, issued May 16, 1899 (renewed for

¹ Application Serial No. 75/672,371, filed April 1, 1999, under
Section 44(e) of the Trademark Act, 15 USC §1126(e), on the basis
of United Kingdom Registration No. 609,540, covering the same
mark for lubricating oils. That registration issued on October
31, 1939, and is currently valid until October 31, 2002.

the fourth time in 1989) for the mark VISCOLITE for lubricating oils. The Examining Attorney has also refused registration under Section 2(e)(4) of the Act, 15 USC §1052(e)(4), arguing that applicant's mark is primarily merely a surname. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We affirm on both grounds.

Likelihood of Confusion Refusal

Arguing that one feature of a mark may be given more weight in the likelihood-of-confusion analysis, the Examining Attorney contends that VISCO, the only shared portion of the respective marks, is the dominant part of registrant's trademark. The Examining Attorney points out that this word appears at the beginning of registrant's mark, and contends that the "LITE" part of registrant's mark is descriptive or suggestive of a characteristic of registrant's goods--that they may be lighter in grade or in some other quality--and that this part of registrant's mark does not significantly change the commercial impression of the mark.

With respect to the goods, the Examining Attorney contends that both are lubricants and that, moreover, the identification in the registration (lubricating oils) is broad enough to include applicant's automobile lubricants.

Therefore, the goods of applicant and registrant are presumed to move in similar channels of trade and are presumed to be available to all potential purchasers of those goods. The Examining Attorney also contends that, if applicant's goods are not considered to be within the scope of the registrant's goods, applicant's goods do nevertheless fall within registrant's "expansion of trade." The Examining Attorney has submitted printouts of five use-based registrations which include the goods of both applicant and registrant. Finally, the Examining Attorney requests us to resolve any doubt on this issue in favor of the registrant and prior user.

Applicant, on the other hand, contends that registrant's (now Exxon Mobil Corporation's) goods, according to information apparently obtained from registrant's Web site, are for heavy-duty machinery. These goods, according to applicant, would be purchased by sophisticated corporate purchasers through distributors for the purpose of lubricating industrial machinery. In view of the specific nature of registrant's goods, applicant maintains that LITE is not suggestive of those goods but is inherently distinctive because registrant's lubricating oils are used in connection with heavy machinery. Because applicant's automotive lubricants are sold through retail

stores, automobile dealerships and repair shops, applicant argues that the different channels of trade, different classes of purchasers and different marks show that confusion is not likely. Finally, applicant's attorney states that both its mark and registrant's mark have been registered in at least five countries as well as the Benelux countries without any instances of actual confusion having arisen.

Likelihood of confusion must be determined on the basis of the identification of goods set forth in the application and the cited registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990), *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USP Q76 (CCPA 1973). Viewed in this light, and not with respect to what registrant's actual lubricating oils may be, we conclude that the respective products here are very closely related if not identical. Registrant's lubricating oils and applicant's automotive lubricants are similar products which, as identified, may be sold in the same channels of trade (automotive retail stores, auto repair shops, etc.) to the same classes of potential purchasers. Also, viewed

in this light, we cannot accept applicant's argument that the purchasers of registrant's goods are sophisticated heavy equipment operators.² Finally, automotive lubricants and lubricating oil are relatively inexpensive items that are likely to be purchased without a great deal of care. This is a factor which tends to increase the likelihood of confusion.

Concerning the marks, we also agree with the Examining Attorney that these marks are very similar, differing only in the descriptive or suggestive component "LITE." We conclude, therefore, that purchasers, aware of registrant's VISCOLITE lubricating oils, who then encounter applicant's VISCO automotive lubricants, are likely to believe that both these lubricating products come from the same source.

Surname Refusal

With respect to this refusal, the Examining Attorney has submitted over six pages of "Visco" surnames from the Phonedisc database showing that a total of 2,199 residential listings of this surname were found. The Examining Attorney argues that no minimum number of directory listings is required. The Examining Attorney

² Moreover, as the Examining Attorney has pointed out, applicant has provided no evidentiary support for the argument that registrant's purchasers are sophisticated.

also argues that there is no other meaning to the term "VISCO." Accordingly, the Examining Attorney argues that he has made out a prima facie case of primary surname significance.

Applicant, on the other hand, argues that the surname "Visco" is relatively rare because only 2,199 surnames were found out of a total of 115 million, or one out of every 50,000 people. Applicant's attorney indicates that in the Chicago telephone directory, only 3 "Visco" surnames appear (out of a population of 3 million). Moreover, applicant maintains that the mark was adopted to connote "viscosity," an important attribute of lubricants. Applicant maintains that no one associated with applicant has this surname, that there is no recognized meaning of this term and that the asserted mark does not have the "look and feel" of a surname. Accordingly, it is applicant's position that the term VISCO will be seen as an arbitrary brand of lubricants.

A mark is primarily merely a surname if its primary significance to the purchasing public is that of a surname. *In re Kahan and Weisz Jewelry Manufacturing Corp.*, 508 F.2d 831, 184 USPQ 421 (CCPA 1975). See also *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985).

We agree with the Examining Attorney that a prima facie case of surname significance has been established by the introduction of a listing of a not insignificant number of persons having this surname in this country. Also, applicant has admitted that the asserted mark has no recognized meaning (although applicant does argue that it suggests "viscosity"). Moreover, as the Examining Attorney contends, there is no evidence to support applicant's argument that the mark has the connotation applicant alleges, or would be so perceived. Accordingly, we believe that applicant has failed to rebut the prima facie case of surname significance.

Decision: The refusal of registration is affirmed on both grounds.